

REMARKS

I. Summary of Office Action

Claims 1-19 and 37-48 were pending in this application.

Claims 1-19 and 37-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner et al., U.S. Patent No. 5,830,068 ("Brenner '068") in view of Dan Wagner et al., The Human Factors Design Guide ("HFDG"), and Lawler et al., U.S. Patent No. 5,805,763 ("Lawler").

Claims 1-19 and 37-48 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of Brenner et al., U.S. Patent No. 6,004,211 (hereinafter "Brenner '211").

II. Summary of Telephonic Interview

The Examiner and the undersigned conducted a telephonic interview on June 16, 2004. The undersigned wishes to thank the Examiner for the courtesies extended during the interview.

During the interview, the rejection of the claims in the above-identified patent application were discussed. More specifically, as noted in the Interview Summary, independent claims 1 and 37 were discussed and an agreement was not reached.

III. Summary of Applicants' Reply to Office Action

Claims 1 and 37 have been cancelled without prejudice because an agreement could not be reached during the interview. Accordingly, applicants have cancelled claims 1 and 37 and will continue prosecuting independent claims 19 and 48 in order to advance prosecution. Claims 2-18 and 38-47 were previously dependent on claims 1 and 37, respectively. Claims 2, 4, 11, 14-18, 38 and 43-46 have been amended such that claims 2-18 and 38-47 are now dependent on claims 19 and 48, respectively.

Applicants respectfully submit that the subject matter of amended claims 2, 4, 11, 14-18, 38 and 43-46 are fully supported by the originally-filed specification. No new subject matter has been added.

The Examiner's rejections are respectfully traversed.

IV. Applicants' Reply to the Rejections Under § 103(a)

Claims 2-19 and 38-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner '068 in view of HFDG and Lawler. Applicants' independent claims 19 and 48 generally relate to systems and methods for allowing users to wager on and record wagering events. A user is allowed to create and place a wager for a given race and is automatically provided with an opportunity to record the given race in response to the user placing the wager for the given race. The given race is then recorded.

A. Brenner, Lawler And HFDG Fail To Show Or Suggest Automatically Providing A User With An Opportunity To Record A Race In Response To Placing A Wager on That Race

As stated in the Office Action, Brenner '068 discloses an interactive wagering system that allows users to create and place wagers by interacting with an interactive wager-creation interface (see Brenner '068, FIGS. 36-39 and 41-44).

Brenner '068 also shows that a selectable option associated with a given race may be presented, and that the user may select the option to record the race (see Brenner '068, column 28, lines 4-23 and FIG. 49). However, the Examiner concedes that Brenner does not show automatically providing the user with an opportunity to record the given race in response to the user placing the wager for the given race (see Office Action, page 5). The Office Action attempts to show this feature of applicants' claims using the disclosure from Lawler.

Lawler generally relates to an interactive television program guide for allowing users to browse and select television programs (see Lawler, abstract). The Examiner contends that Lawler automatically provides users with an opportunity to record a given event in response to the user placing an order for a given item in FIGS. 4A, 4B and 6-10 (see Office Action, page 5). Applicants respectfully disagree. Program options menu 136 of FIG. 6 includes both order button 138 and record button 130. Applicants submit that these two buttons provide

distinct options for a user, and that in response to the selection of order button 138, the option to record a program is not automatically provided to the user, as contended by the Examiner. The flow diagram in FIG. 7 of Lawler illustrates this point.

FIG. 7 shows the steps taken if one of the buttons in program options menu 136 of FIG. 6 is selected. More specifically, if order button 138 in program options menu 136 is selected, the system proceeds to block 306 where a menu to facilitate ordering is then displayed at block 308. At block 310, the system monitors and implements the user's selections from the ordering menu and then at block 312 the system returns to the program time guide of FIG. 3. Nowhere in this process is it shown or suggested that the user is automatically provided with an opportunity to record a program as the Examiner contends. Therefore, Lawler does not show or suggest automatically providing users with an opportunity to record a program in response to the user placing an order for the program, as the Examiner contends. Thus, since Lawler does show or suggest automatically providing users with an opportunity to record a program in response to the user placing an order for the program, it cannot show or suggest "automatically providing the user with an opportunity to record the given race in

response to the user placing the wager for the given race," as required in applicants' independent claims 19 and 48.

The Office Action appears to rely on HFDG to provide the motivation to combine Brenner with Lawler, but it also relies on three sections in HFDG to modify the user interface disclosed in Brenner '068 to show features of applicants' claims. The Examiner first refers to section 8.1.6.3 of HFDG which states that "[t]he system or application shall provide the user whatever information is required to guide control entries." As an example, section 8.1.6.3 states that "[p]rompts may be incorporated into a display at any point in a transaction sequence that will be helpful." (HFDG, page 8-14, emphasis added). Applicants respectfully submit that this section merely shows, in a broad sense, that it would be helpful to provide prompts. However, nowhere is it shown or suggested in this section that it would be helpful to automatically provide the user with an opportunity to record a race in response to a user placing a wager for the race.

The Examiner also points to sections 8.1.11.1.7 and 8.1.11.3.5 of HFDG, which refer to providing menu options, in an attempt to show features of applicants' claims. More specifically, section 8.1.11.1.7 states that menus should display all options that are available to a user at a step in a transaction sequence (see HFDG, page 8-20). Section 8.1.11.3.5

states that critical or frequently selected options should be easily accessible to a user (see HFDG, page 8-22). The Examiner contends that HFDG suggests modifying Brenner '068 to display all available options and to give access to frequently used functions (see Office Action, page 6). However, applicants submit that the Office Action has not shown or suggested that providing the user with an opportunity to record a race in response to placing a wager is an available option in the transaction sequence. Furthermore, applicants submit that the Office Action has not shown or suggested that applicants' claimed feature is critical or a frequently used function. In fact, applicants' claim requires providing the user with the opportunity to record a race in response to the user placing a wager for the race. If recording a race is considered critical or frequently used, then it would seem that this feature should be part of the wager creation process, and not displayed in response to placing a wager.

Therefore, at least because Brenner, Lawler and HFDG do not show or suggest "automatically providing the user with an opportunity to record the given race in response to the user placing the wager for the given race," applicants respectfully submit that the rejection of independent claims 19 and 48 under 35 U.S.C. § 103(a) should be withdrawn.

B. The Office Action Failed To Provide
Sufficient Motivation To Combine

The Office Action has failed to provide sufficient motivation for combining the references to justify the assertion of a § 103 rejection. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"); see also MPEP § 2142 and 2143.01. It is well-settled that an Office Action can "satisfy this burden only by showing some objective teaching ... that would lead [one of ordinary skill in the art] to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

As mentioned above, the Office Action conceded that Brenner does not automatically provide the user with an opportunity to record the given race in response to the user placing the wager for the given race. It attempted to the modify Brenner '068 to include this feature by relying on broad teaching in Lawler of automatically providing users with an opportunity to record a given event in response to the user placing an order for an item (see Office Action, page 6). However, as demonstrated above, Lawler does not show or suggest this teaching. Therefore, Lawler lacks the requisite motivation to modify Brenner '068 to show or suggest with objective evidence applicants' claimed feature.

As further demonstrated above, the sections of HFDG cited in the Office Action failed to show or suggest automatically providing the user with an opportunity to record a race in response to a user placing a wager for the race. In fact, some of the other sections of HFDG, when taken as a whole, teach away from applicants' claimed feature. For example, section 8.1.14.2.2 of HFDG states that only information that is relevant to a task should be included in a system or application (see HFDG, page 8-32). However, nowhere is it shown or suggested that providing the user with the opportunity to record a race is relevant to the task of placing a wager on the race. Therefore, HFDG would seem to suggest to not provide the user with the opportunity to record a race in response to the user placing a wager on the race.

Another example is found in section 8.1.14.4.2 of HFDG which states that a user's effort should be minimized by reducing the number of keystrokes required of users (see HFDG, page 8-33). Applicants' claims require providing the user with the opportunity to record the race in response to placing a wager. This may add keystrokes, however, which is discouraged by HFDG. If HFDG suggests minimizing keystrokes, then HFDG would seem to suggest that the user should be provided with the opportunity to record the race while placing a wager, not in response to placing the wager.

These two exemplary teachings, illustrate how HFDG teaches away from applicants' claimed approaches. In addition, applicants respectfully submit that there is no objective evidence of record, other than applicants' disclosure, that would lead one skilled in the art to modify Brenner '068, Lawler and HFDG to automatically provide users with an option to record a race "in response to the user placing the wager for the given race" as specified by applicants' claims. Without objective evidence of a motivation to modify the references to arrive at applicants' claimed approach, the Office Action "simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability," a practice that is insufficient as a matter of law. See In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999); see also In re Lee at 1344 ("[i]t is improper, in determining whether a person of ordinary skill would have been led to a combination of references, simply to use that which the inventor taught against its teacher").

Therefore, because neither Brenner '068, Lawler, HFDG, nor their combination show or suggest applicants' claimed approach, applicants respectfully submit that a *prima facie* case of obviousness had not been met and that the rejections of independent claims 19 and 48 under 35 U.S.C. § 103(a) should be withdrawn. See MPEP § 2143.

Claims 2-18 are dependent from claim 19 and are allowable at least because claim 19 is allowable. Claims 38-47 are dependent from claim 48 and are allowable at least because claim 48 is allowable.

V. Applicants' Reply to the Double Patenting Rejections

Claims 2-19 and 38-48 were rejected under the judicially created doctrine of obviousness-type double patenting (analogous to a rejection under 35 U.S.C. § 103 according to MPEP § 804(II)(B)(1)) as being unpatentable over claims 1-59 of Brenner '211. Applicants respectfully submit, however, that the obviousness-type double patenting rejection is improper.

It is well settled that, in cases where double patenting may be at issue, "it must always be carefully observed that the ... patent [used as the basis for a double patenting rejection] is not 'prior art' under either section 102 or section 103 of the 1952 Patent Act (35 U.S.C. as amended)." In re Boylan, 392 F.2d 1017, 1018; see also In re Braithwaite, 379 F.2d 594, 600, n.4 ("While analogous to the non-obviousness requirement of 35 U.S.C. § 103, that section is not itself involved in double patenting rejections because the patent principally underlying the rejection is not prior art"). Indeed, the courts have determined that a double patenting rejection is reserved for situations "where patents are not citable as a reference against each other and therefore can not

be examined for compliance with the rule that only one patent is available per invention." Eli Lilly & Co. v. Barr Labs., 251 F.3d 955, 966 (Circuit Judge Newman dissenting, in a separate opinion, on the Court's refusal to reconsider the case en banc); see also General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1278.

In the present case, Brenner '068 was filed on September 8, 1995 and issued on November 3, 1998, which is before the date of applicants' claimed invention.* Accordingly, the claims and disclosure of Brenner '068 are statutory prior art under 35 U.S.C. § 102(a). The Examiner agreed with the applicants' arguments in the November 20, 2003 Reply to Office Action that the double patenting rejection based on the claims of Brenner '068 was improper and withdrew the rejection (see Office Action, page 2).

The Examiner, however, maintained the double patenting rejection with respect to Brenner '211, which was filed on August 24, 1998, issued on December 21, 1999 and claims priority from Brenner '068. The Examiner contended that "obviousness-type double patenting is determined based on comparison of claims, not disclosures. . . the fact that two inventions share

* Applicants' non-provisional patent application was filed on January 30, 2000 and claims priority from U.S. provisional patent application No. 60/142,174, filed July 1, 1999.

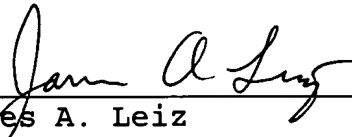
a common disclosure is no matter in determining obviousness-type double patenting" (Office Action, page 4). However, Brenner '211 claims priority from Brenner '068 and the subject matter of the claims in Brenner '211 is fully supported and disclosed in Brenner '068. Therefore, applicants submit that the obviousness-type double patenting rejection based on the subject matter of claims 1-59 of Brenner '211 is improper because this subject matter is disclosed in Brenner '068 which is available as prior art under 35 U.S.C. § 103. Accordingly, the obviousness-type double patenting rejections should be withdrawn.

However, even if the double-patenting rejection is found to be proper, applicants respectfully submit that, for the same reasons set forth above in connection with the rejection under § 103 over Brenner '068, applicants' claims 2-19 and 38-48 are not obvious in view of claims 1-59 of Brenner '211.

VI. Conclusion

The foregoing demonstrates that the obviousness-type rejections of claims 2-19 and 38-48 should be withdrawn. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



James A. Leiz
Registration No. 46,109
Agent for Applicants
FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
Tel.: (212) 596-9000